THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAROLD H. HOPFE

Appeal No. 95-4091
Application 08/106,742[1]

ON BRIEF

Before PAK, WARREN, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 6 and 7, which are all of the claims

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[1] Application for patent filed August 16, 1993.

remaining in the application. Claims 1 through 5 and 8 through 9 have been canceled.

THE INVENTION

Appellant's invention is directed to a method of preparing a prelaminate for a safety glazing containing a thermoplast sandwiched between layers of glass. Each side of the thermoplast has a different surface pattern. One side has a regular roughness pattern. The other side has a random roughness pattern. The required process steps of the claimed subject matter, air removal and heat, result in a partial transfer of the regular roughness pattern to the other side of the interlayer having a random roughness pattern. The prelaminate formed is capable of transmitting at least 85% of light incident thereon.

THE CLAIMS

Claim 6 is illustrative of appellant's invention and is reproduced below.

6. In the method of preparing a prelaminate for a safety glazing by deairing the interface with glass on each rough-surfaced side of a thermoplastic interlayer and heating the interlayer and glass to collapse the rough surfaces, the

improvement facilitating deairing wherein a regular roughness pattern on one side of the interlayer is partially transferred to and imposed on a random roughness pattern on the other side of the interlayer to provide deair paths which are less obstructed than those of the unmodified random pattern, thereby providing a prelaminate capable of transmitting at least 85% of light incident thereon.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference of record.

Sato et al. (Sato)	4,452,840	Jun. 5, 1984

THE REJECTION

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as unpatentable over Sato.

OPINION

As a preliminary matter, appellant has stated that claims 6 and 7 stand or fall together. See 37 CFR §1.192(c)(5)(1993). See appellant's Brief, page 4. Our opinion will focus on a specific limitation of the claimed subject matter shared by both claims and dispositive of this appeal.

We have carefully considered all of the argument advanced by the appellant and the examiner and agree with appellant that the aforementioned rejection is not well founded. Accordingly, we will not sustain the rejection.

The claimed subject matter before us is drawn to a method which provides, "a prelaminate capable of transmitting at least 85% of light incident thereon." See claim 6. The

Answer, page 3, relies upon and incorporates the rejection set forth in the final rejection of September 7, 1994 (Paper No. 7). The examiner states therein, page 4, "[i]t is noted that the property of transmittance depends on several material-related (i.e., type of interlayer and thickness) and operational parameters (i.e., the pressure used for deairing and the vacuum, pressure and temperature used in bonding) in the recited process which are well known in the art. For example, the apparent 53%-72% transmittance shown by the Sato et al reference is clearly dependent upon the temperature of the laminate just before the pressure bonding step, See Table I." The examiner has restated his position in the Answer, pages 6 and 7 that, "only the operating conditions (more specifically, pressure and temperature) used during the mating/lamination of the glass sheets with the plastic interlayer will determine the percent light transmittance in the resulting product."

It is well settled that the initial burden of proof lies with the examiner to establish a *prima facie* case of obviousness under § 103. In re Oetiker, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992). The fact that

the prior art may be modified to reflect a particular feature of the claimed subject matter, such as the 85% transmittance, which modification is not made, does not make the claimed subject matter obvious. The desirability of such modification must be suggested by the prior art. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-1784 (Fed. Cir. 1992). Specifically, Sato, in Table I, discloses transparency percentages between 53% and 72%. There is no suggestion in Sato of obtaining transparency in excess of 72% nor even the desirability of achieving a transparency of greater than 72%. Accordingly, even were the examiner correct in his analysis that the conditions of Sato's process could be modified to obtain a transparency of 85% or more, the modification nonetheless would have been unobvious as the prior art fails to suggest the desirability of the modification.

Moreover, we disagree with the examiner's analysis of the operating conditions for Sato's process and the conclusions drawn therefrom. We recognize that in considering the disclosure of Sato, the examiner may take into account not only the specific teachings, but also inferences which one skilled in the art would reasonably have been expected to draw

therefrom. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). However, the examiner's explanation that the "percent light transmittance in the resulting prelaminate would clearly depend upon the operating conditions of the laminating step of the process," is inadequate to reasonably draw an inference or conclusion that Sato's process could be modified to achieve a transparency of 85%.

Our conclusion is supported by an analysis of Sato's operating conditions. Reference to Table I of Sato discloses an inverse correlation between transparency and temperature for Exp. I. and a direct correlation between temperature and transparency for Exp. II. It is accordingly reasonable to conclude that no inferences can be drawn between the operating conditions of Sato's method and transparency.

Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

DECISION

The rejection of claims 6 and 7 as unpatentable over Sato under 35 U.S.C. § 103 is reversed.

The decision of the examiner is reversed.

REVERSED

Chung K. Pak Administrative Patent Judge	)	
Charles F. Warren Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Paul Lieberman Administrative Patent Judge	)	

tdc

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